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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,841	08/31/2001	Teresa B. Badura	YOR9-2001-0552-US1	2827
28211	7590	08/11/2005	EXAMINER	
FREDERICK W. GIBB, III MCGINN & GIBB, PLLC 2568-A RIVA ROAD SUITE 304 ANNAPOLIS, MD 21401			GRAYSAY, TAMARA L	
			ART UNIT	PAPER NUMBER
			3623	
DATE MAILED: 08/11/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/943,841	<b>Applicant(s)</b> BADURA ET AL.	
	<b>Examiner</b> Tamara L. Graysay	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ( <u>1 page</u> ). | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 31 August 2001 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

In the present application, the Form PTO-1449 reads in part, "Japan (w/Abstract)" however, no abstract for the Japanese document was received.

### ***Drawings***

2. The drawings are objected to because of the following:

For clarity, the acronyms used in Figure 4A should be spelled out in the drawing or the specification. If the acronyms are trademarks, then they should be capitalized wherever they appear and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

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renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 10-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to nonstatutory subject matter.

a. The claims are not within the technological arts. The methods are directed to steps of inputting (which does not require technology, but rather only requires that a person performing the method obtain information related to the party's ability to communicate) without use of any technology. The disclosure includes the embodiment where the step of inputting includes a type of initialization for a decision tree that is implemented mentally, manually, and/or using paper and pencil.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-5 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson (article, The use and impact of communication media in purchasing and supply chain management).

a. Regarding claims 1-5, Larson discloses a method of inputting an ability to communicate (29:summary- Generally the article discusses the various communication arrangements that are available in a buyer-supplier relationship, including phone, fax, mail, and Internet/web), evaluating a communication arrangement (29:introduction:¶3- the best technology or medium for buyer-supplier communication depends on characteristics of the message; 31:high tech vs. high touch:¶1-5- the buyer-supplier communications include strategic and tactical communications) and repeating the evaluation for a different communication arrangement is the ability does not match (34:Table I- for example, the article mentions the use of a particular communication arrangement, such as phone, fax, mail, and Internet/web and also mentions that all parties do not use all arrangements).

Larson mentions a buyer's consideration of a particular communication arrangement dependent upon the relationship the buyer has with the supplier and the characteristics of the communication, but does not explicitly mention the supplier's limitations as to a particular communication arrangement. The examiner takes Official notice that the use of communication media is within the level of ordinary skill in the business field and is a preference that the supplier can make based on its corporate strategy. In other words, if a supplier works with a particular buyer, the decision to change the status quo is dependent upon, but not limited to, the supplier's relationship

with the buyer, constraints within the relationship, and benefit to the supplier. For example, in light of the not so distant objections to telemarketing, a business would consider other types of communication to reach buyers. As such, it would follow that a buyer that cannot communicate with a supplier in a preferred arrangement would try another communication arrangement that is compatible with the buyer-seller relationship.

b. Regarding claims 14-18 as presented, and claims 1-5, if interpreted as including technology, Larson does not expressly show automating the process steps.

It was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art. In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating, i.e., using a computer storage device embodying program instructions for performing the step of evaluating a communication arrangement and implementing the arrangement that matches the most desirable for the evaluator, gives one just what one would expect from the manual step as shown in Larson. In other words there is no enhancement found in the claimed steps. The claimed evaluating and implementing steps only provide automating a manual activity of evaluating a communication arrangement to determine a match. If one were to call and get no answer, a different arrangement would likely be implemented until communication can in fact be implemented. The end result, a communication exchanged between a buyer and supplier, is the same as compared to the manual method; however, a computer can simply iterate the steps faster and more consistently.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Larson to include automating the evaluating and implementing steps because this would speed up the process of matching communication arrangements with customers, which is purely known and disclosed in Larson, and the same result is obtained from automation of that which is already known in the art.

5. Claims 6-13, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson (article, The use and impact of communication media in purchasing and supply chain management) in view of Burk (article, Major changes look as industry approaches the internet frontier).

a. Regarding claims 6-13 Larson teaches the steps of inputting, evaluating, and implementing, as noted in the rejections of claims 1-5 above, however, Larson lacks the step of performing a cost-benefit analysis with respect to a communication arrangement and comparing the costs of various communication arrangements.

The examiner takes Official notice that cost-benefit analysis are common in the business field to aid in the decision making process of an organization. Burk, for example, teaches the step of cost-benefit analysis of various purchasing and procurement communications types (145:rt:¶2). Burk mentions, for example that the use of Internet/web communications has resulted in dramatic benefits and cost savings for an organization.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Larson to include a cost-benefit analysis

because cost-benefit analysis are well known in the business field as evidenced by the cost-benefit analysis performed in Burk as it applies to purchasing and procurement, in order to improve cost savings and benefits for an entire organization.

b. Regarding claims 19 and 20, Larson teaches the steps of inputting, evaluating, and implementing, as noted in the rejection of claims 14-18 above, however, Larson lacks the instructions for performing a cost-benefit analysis with respect to a communication arrangement and comparing the costs of various communication arrangements.

The examiner takes Official notice that cost-benefit analysis are common in the business field to aid in the decision making process of an organization. Burk, for example, teaches the step of cost-benefit analysis of various purchasing and procurement communications types (145:rt:¶2). Burk mentions, for example that the use of Internet/web communications has resulted in dramatic benefits and cost savings for an organization.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Larson to include a cost-benefit analysis because cost-benefit analysis are well known in the business field as evidenced by the cost-benefit analysis performed in Burk as it applies to purchasing and procurement, in order to improve cost savings and benefits for an entire organization.



*Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


- Jaben-Eilon (article, Ordering made easy...) teaches orders sent by telephone, fax, postal mail; and automating the procurement process to reduce cost, increase efficiency, and enhance information management (p.2).
- Magal (article, An exploratory study...) teaches customer focus when making automation implementation decisions (p.2, left col., ¶2) analyzing the benefits of electronic commerce (p.2, right col., ¶3). Magal also mentions sale of output as an organization function (p.3), procurement as a required activity (p.4), allowing customers to order online (p.5, table 1).
- Lankford (article, electronic data interchange...), Vijayasathy (article, Adoption factors...), and Premkumar (article, Implementation of electronic data interchange...) teach general state of the art regarding electronic data interchange among buyers and sellers.
- The Pastore articles teach implementation of electronic means to make purchases and the benefits thereof.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (571) 272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 8/8/05  
Tamara L. Gray

Examiner

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